



Case 6887

AP/8
2833

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#28
T. BELL.
9.24.03

In re Application of :
BRITTA DAUME :
Serial No.: 09/491,841 :
Filed: August 23, 1999 :
For: A DEVICE FOR CONTACTING IN :
PARTICULAR ELONGATED, :
ILLUSTRATIVELY SUBSTANTIALLY :
CYLINDRICAL BODIES SUCH AS :
CABLES OR PIPES/TUBES :

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REQUEST FOR REINSTATEMENT OF APPEAL
UNDER 37 C.F.R. § 1.193(b)(2)(ii)

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22312-1450

Dear Sir:

In an Office Action mailed April 15, 2003 the examiner has reopened prosecution. Applicant hereby requests reinstatement of their appeal as provided under 37 C.F.R. § 1.193(b)(2)(ii). A supplemental appeal brief is attached.

MPEP § 706 states: "The goal of examination is to clearly articulate any rejection *early in the prosecution* process so that applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the *earliest opportunity*. The examiner should never overlook the importance of his or her role in *allowing claims which properly define the invention*" (emphasis added).

Over a three year period, applicant has expended considerable effort in their attempt to resolve a single issue with the examiner; namely, the failure of certain prior art (Cauderay et al. and Tinnerman '627) to suggest combination and therefore *prima facie* obviousness.

These efforts included filing several responses and requests for reconsideration, a continued prosecution application after issuance of a first final rejection, and conducting a personal interview with the examiner prior to receiving a second final rejection. Notwithstanding the above, the examiner maintained the rejection in no less than five separate office actions thereby exhausting applicant's options and necessitating filing of an appeal and brief. The arguments provided in the brief are essentially the same as those submitted throughout prosecution.

In response the examiner reopened prosecution and withdrew the rejection, agreeing with applicant's long-standing position that the prior art failed to meet the minimum requirements of *prima facie* obviousness. More significantly, the examiner applied a new rejection based upon prior art (Ellinwood) which was of record and available to the examiner since the time of the first office action over three years ago. Applicant had not necessitated this new rejection by either changing the claims on appeal or otherwise shifting the issues concerning patentability. Also, applicant must now respond at this late stage of the proceedings to yet another indefinite rejection even though all

resolved.

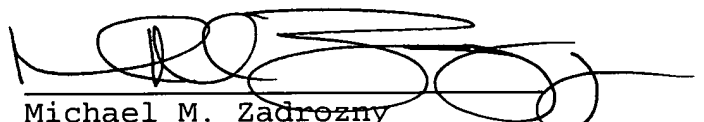
It is respectfully submitted the above shows the examiner has not clearly articulated rejections early in prosecution whether based upon prior art or claim construction, has denied applicant a fair opportunity to provide evidence of patentability in a timely manner or otherwise reply completely at the earliest opportunity to all prior art known to the examiner and that the examiner has overlooked the importance of her role in allowing claims which properly define the invention.

It is submitted the above establishes good cause for why the appeal should be reinstated. Applicant is entitled to reinstatement for reasons of equity and fairness.

A check in the amount of \$205.00 is attached in payment of a two (2) month extension of time extending the due date for responding to the Official Action mailed April 15, 2003 from July 15, 2003 to September 15, 2003. Small entity status has been previously established. Should this amount be insufficient, then please charge the deficiency to Deposit Account No. 19-2105 and notify the undersigned.

Respectfully submitted,

Date: AUGUST 28, 2003


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